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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,872	02/10/2004	Bao Ha	Serie 5545	3882

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EXAMINER	
MCNELIS, KATHLEEN A	

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/776,872	HA ET AL.	
	Examiner	Art Unit	
	Kathleen A. McNelis	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claims Status

Claims 13-17 remain for examination.

Examiner's Comments

Applicant has not addressed the nonstatutory obviousness type double patenting rejection over Ha et al. (U.S. Pat. No. 6,692,549) made in the 3/11/2005 office action (pp. 7-8) and maintained in the 8/22/2005 and 2/6/2006 office actions. In the June 7, 2005 response to the 3/11/2005 office action, applicant stated that a TD had been filed to over come the rejection. In both the 8/22/2005 (p. 8) and the 2/6/2006 (p. 7) office actions, examiner has noted that the TD has not been received. Applicant has not traversed the rejection or provided a TD to overcome the rejection.

Status of Previous Rejections

The previous rejection of claims 13-17 under 35 U.S.C. 103(a) as being unpatentable over Grenier (U.S. Pat. No. 5,244,489) in view of Rathbone (5,268,016) is maintained.

The previous rejection of claims 13 to 17 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of Ha et al. U.S. Patent No. 6,692,549 is maintained.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grenier (U.S. Pat. No. 5,244,489) in view of Rathbone (5,268,016).

Grenier in view of Rathbone is applied as discussed in the 2/6/2006 office action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13 to 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of Ha et al. U.S. Patent No. 6,692,549.

Ha et al. is applied as discussed in the 2/6/2006 office action.

Response to Arguments

Applicant's arguments filed on 7/10/2006 have been fully considered but they are not persuasive.

Applicants argue that:

1. Grenier '489 neither teaches nor suggest that "additional compressed air" be combined with "feed air to the blast furnace" to produce "combined feed air stream," but rather Grenier '489 teaches away from the requirement of "additional compressed air" being added to the portion of air that is diverted from the blast furnace feed.

2. Rathbone '019 fails to remedy the deficiency in Grenier '489 related to additional compressed air.
3. There is no motivation to combine Grenier '489 with Rathbone.
4. The two blowers disclosed in Grenier '489 would presumably comprise a redundant train that would allow for off-line maintenance of one blower while the other satisfies the full requirement of the blast furnace.

Examiner's responses to these arguments are as follows:

1. Examiner maintains that the disclosure of Grenier '489 meets the limitations claimed in the instant invention. The instant claims do not recite that the additional compressed air is "...being added to the portion of air that is diverted from the blast furnace feed" as argued, but rather that "...wherein said first portion of air is mixed with additional compressed air resulting in a combined feed air stream..." which is met by Grenier '489 blowers (3) in parallel to stream 5 as discussed on page 4 of the 2/6/2006 office action. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
2. Rathbone is used to show that it is know to be advantageous to recover work from nitrogen produced by the air separation plant as discussed on pages 4-5 of the 2/6/2006 office action, rather than compressed air feed as argued.
3. The motive is discussed on page 5 of the 2/6/2006. The combination of teachings is proper because both Grenier and Rathbone disclose air separation plants, therefore the references are analogous. Grenier discloses separation of nitrogen and oxygen streams, and using the oxygen in a process, but does not disclose a use for

the nitrogen. Rathbone teaches that it is advantageous to recover work from the nitrogen stream (see p. 5 of 2/6/2006 office action).

4. The instant claims are drawn to an apparatus (i.e. system). The manner of operating a device does not differentiate an apparatus from the prior art. "[A]pparatus claims cover what a device *is*, not what a device *does*" (M.P.E.P. 2114). The two blowers disclosed by Grenier are capable of providing compressed air at the same time, and therefore meets this claim limitation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen A. McNelis whose telephone number is 571 272 3554. The examiner can normally be reached on M-F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KAM
9/26/2006

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